

ESTTA Tracking number: **ESTTA584829**Filing date: **01/30/2014**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Petition for Cancellation**

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Professional Appearance Group/Writco, Inc.		
Entity	Corporation	Citizenship	California
Address	23679 Calabasas Road Suite 356 Calabasas, CA 91302 UNITED STATES		

Attorney information	Pete Bromaghim Blakely, Sokoloff, Taylor & Zafman LLP 12400 Wilshire Blvd. 7th Floor Los Angeles, CA 90025 UNITED STATES pete_bromaghim@bstz.com, garbo_tat@bstz.com, tm_filings@bstz.com Phone:310.207.3800
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Registration Subject to Cancellation

Registration No	4100402	Registration date	02/14/2012
Registrant	Cespedes, Ernesto, Felipe 23200 Camino Del Mar #707 Boca Raton, FL 33433 USX		

Goods/Services Subject to Cancellation

Class 045. First Use: 2011/04/29 First Use In Commerce: 2011/04/29
All goods and services in the class are cancelled, namely: Providing legal services online and in person

Grounds for Cancellation

<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Priority and likelihood of confusion	Trademark Act section 2(d)
Other	Non-use

Mark Cited by Petitioner as Basis for Cancellation

U.S. Application No.	85897447	Application Date	04/08/2013
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	ATTORNEYS ON DEMAND		

Design Mark	Attorneys On Demand
Description of Mark	NONE
Goods/Services	Class 035. First use: First Use: 2006/05/17 First Use In Commerce: 2006/05/17 Arranging for attorneys, on a temporary and independent contractor basis, to make appearances in court and in other legal proceedings, on behalf of client/customer law firms and attorneys who are the attorneys of record in such proceedings

Attachments	85897447#TMSN.jpeg(bytes) 9751.M001 Petition to Cancel - ATTORNEY ONDEMAND.PDF(472013 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/PeteBromaghim/
Name	Pete Bromaghim
Date	01/30/2014

PROFESSIONAL APPEARANCE GROUP /
WRITCO, INC.
d/b/a ATTORNEYS ON DEMAND,

Petitioner,

v.

ERNESTO CESPEDES,

Respondent.

PETITION FOR CANCELLATION

2. Since at least as early as May 2006, Petitioner has operated a national court appearance service, the first of its kind, under its service mark ATTORNEYS ON DEMAND. Since then, Petitioner has worked with law firms and attorneys to attend court hearings in cities

throughout the United States. Petitioner's extensive use and promotion of its ATTORNEYS ON DEMAND mark since 2006 illustrates the distinctiveness of that mark to relevant consumers, and its value to Petitioner.

3. On April 8, 2013, Petitioner filed a use-based application for its ATTORNEYS ON DEMAND trademark, U.S. Trademark Application Serial No. 85/897,447, for use in connection with "Arranging for attorneys, on a temporary and independent contractor basis, to make appearances in court and in other legal proceedings, on behalf of client/customer law firms and attorneys who are the attorneys of record in such proceedings" in Class 35¹ ("Petitioner's Application"). Petitioner's Application is currently pending at the U.S. Patent and Trademark Office ("PTO"). Petitioner will be requesting suspension of the prosecution of Petitioner's Application pending the outcome of this Petition.

4. Upon information and belief, Ernesto Felipe Cespedes ("Respondent") is an individual U.S. citizen with a principal address of 23200 Camino Del Mar #707, Boca Raton, FL 33433. Upon information and belief, Applicant is a licensed attorney in the State of Florida.

5. Upon information and belief, Respondent owns U.S. Registration No. 4,100,402 (hereinafter the "Registration"), for the mark ATTORNEY ONDEMAND, which is registered on the Supplemental Register. According to PTO records, the application was filed on May 13, 2011, amended to the Supplemental Register on October 7, 2011, and was registered on the same on February 14, 2012. The services on the registration are "providing legal services online and in person," in International Class 45.

6. Petitioner is likely to be damaged by the continuance of the Registration in that Petitioner's Application has been refused registration by the PTO based on the existence of the

¹ Petitioner's services are or will be amended to those in Class 45.

Registration. Petitioner was not previously aware of Respondent's alleged use of its mark or application for the same. Petitioner is also damaged by the Registration in that it may be perceived to affect Petitioner's rights in its mark, including demonstrating Petitioner's exclusive right to use its ATTORNEYS ON DEMAND mark and/or its distinctiveness to consumers.

7. There is no question as to priority of use. Petitioner began using its ATTORNEYS ON DEMAND mark in interstate commerce in 2006, five years prior to Respondent's alleged use of its mark in April 2011. Additionally, to the extent Petitioner's mark may have been perceived as not inherently distinctive upon its initial adoption, the ATTORNEYS ON DEMAND mark acquired distinctiveness prior to Respondent's alleged first use in commerce.

8. Petitioner is therefore entitled to cancellation of the Registration based on its priority of use and the resulting likelihood of confusion resulting from Respondent's junior use under Lanham Act § 2(d).

9. Upon information and belief, Respondent was not using its ATTORNEY ONDEMAND mark in commerce as of the filing date of the Respondent's Application. Respondent declared, under notice of 18 U.S.C. § 1001 and being warned that willful false statements and the like may jeopardize the validity of the Registration, that the mark as shown in the Registration was in fact being used as of the first-use date of April 29, 2011 submitted with the application. In prosecuting the application, Respondent submitted additional proposed specimens of use on two occasions, and each time confirmed that the substitute specimen was in use in commerce as of the application filing date, when it was not. The Registration should therefore be invalidated on grounds of non-use in commerce at the time of filing the use-based application.

10. Respondent's false statements regarding the use of the ATTORNEY ONDEMAND mark in commerce were made knowingly, by a licensed attorney, with intent to deceive the PTO. These false statements of material fact include, but are not limited to, (i) Respondent's claim in the application (filed May 13, 2011) that the Respondent's ATTORNEY ONDEMAND mark was first used in commerce on April 29, 2011, (ii) that the specimen of use submitted with the application, the specimen of use submitted with the Response to Office Action dated October 7, 2011, and/or the specimen of use submitted with the Response to Office Action dated December 16, 2011 were in use in commerce as of the filing date of the application. Respondent personally signed declarations affirming to the same. As the mark must be in actual use in commerce to support the Section 1(a) filing basis and registration on the Supplemental Register, these statements are material and were essential to Respondent's ability to register. The Registration should therefore be invalidated based on the Respondent's fraud, and should be cancelled under Section 14 of the Lanham Act.

11. Upon information and belief, Respondent has not and is not using its ATTORNEY ONDEMAND mark in interstate commerce as necessary to support the application and registration of the mark. Respondent's website makes clear that its services, including those under the ATTORNEY ONDEMAND mark, are limited to certain counties in South Florida. Respondent declared, under notice of 18 U.S.C. § 1001 and being warned that willful false statements and the like may jeopardize the validity of the Registration, that the mark as shown in the Registration was in fact used in such commerce.

WHEREFORE, Petitioner prays that this petition for cancellation be granted and that Registration No. 4,100,402 be cancelled.

This Petition for Cancellation is submitted electronically together with an electronic payment in the amount of \$300, the filing fee for one (1) class. The United States Patent & Trademark Office is hereby authorized to charge any additional fees or credit any overpayment to Deposit Account No. 02-2666.

Proof of service of this Petition for Cancellation is attached.

Respectfully submitted,

BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP

Dated: January 30, 2014

A handwritten signature in blue ink, appearing to read 'Peter Bromaghin', is written over a horizontal line.

Peter Bromaghin
Stanley W. Sokoloff
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Los Angeles, California 90025
Telephone: (310) 207-3800
Attorneys for Petitioner

PROOF OF SERVICE

I, Garbo Tat, hereby declare that I am employed by the law firm of
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN, 12400 Wilshire Boulevard, Seventh Floor,
Los Angeles, California 90025-1026; that I am over 18 years of age and not a party to the within
action; and that I served the following document: PETITION FOR CANCELLATION, relating
to REGISTRATION NO. 4,100,402, this 30th day of January, 2014, by causing a true copy
to be deposited in the United States Mail, first class postage prepaid to Respondent as follows:

Ernesto Felipe Cespedes
23200 Camino Del Mar #707
Boca Raton, Florida 33433

Date: 1/30/2014



Garbo Tat